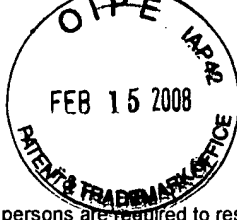


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		RYM-264-169
Application Number		Filed
09/363,413		July 29, 1999
First Named Inventor		FISCHER et al.
Art Unit	Examiner	
2131	Avery, Jeremiah L.	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor


☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record 41,426
(Reg. No.)

☐ Attorney or agent acting under 37CFR 1.34.
Registration number if acting under 37 C.F.R. § 1.34 _____

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.


Signature
Raymond Y. Mah

Typed or printed name

703-816-4044
Requester's telephone number

February 15, 2008
Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and selection option 2.

STATEMENT OF ARGUMENTS FOR PRE-APPEAL REVIEW

The following listing of clear errors is responsive to the Final Rejection mailed October 17, 2007 and the Advisory Action mailed December 26, 2007.

Claims 101, 103, 123 and 131 have been indicated as being allowable.

The Final Rejection fails to establish that claims 57-70, 83-89, 109-122 and 124-130 are anticipated under 35 U.S.C. §102(e) by Hurtado et al (U.S. '421, hereinafter "Hurtado").

Independent Claims 57, 83, 109 and 124:

Anticipation under Section 102 of the Patent Act requires that a prior art reference disclose every claim element of the claimed invention. See, e.g., *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1574 (Fed. Cir. 1986). Hurtado fails to disclose every claim element of the claimed invention. For example, Hurtado fails to disclose "A method of transferring authorization to render protected electronic content from a first device to a second device having a device cryptographic key, the method comprising: receiving a **transfer** authorization request having an indicator of the first device, an indicator of the second device, and an indicator of the protected electronic content; [and] updating a first device history table to indicate that the first device is not authorized to render the protected electronic content and updating a second device history table to indicate that second device is authorized to render the protected electronic content based on the received **transfer** authorization request (emphasis added)," as required by independent claim 57. Similar, but not necessarily identical, comments apply to independent claims 83, 109 and 124.

Pages 5-6 of the Final Rejection alleges that col. 13, lines 10-20 of Hurtado teaches the above-noted limitations. Applicant respectfully disagrees. Col. 13, lines 10-20 states the following:

Once an Electronic Digital Content Store(s) 103 completes a valid request for electronic Content 113 from an End-User(s), the Electronic Digital Content Store(s) 103 is responsible for authorizing the Clearinghouse(s) 105 to release the decryption key for the Content 113 to the customer. The Electronic Digital Content Store(s) also authorizes the download of the SC containing the Content 113. The Electronic Digital Content Store(s) may elect to host the SCs containing the Digital Content at its local site

and/or utilize the hosting and distribution facilities of another Content hosting site.

The above-passage of Hurtado discloses releasing a decryption key for content to a customer. However, this teaching of releasing a decryption key for content clearly fails to disclose updating a first device history table to indicate that the first device is not authorized to render the protected electronic content based on a received transfer authorization request. In other words, Hurtado's released decryption key may effectively authorize the download of content, but clearly does not teach or suggest de-authorizing a first device in a first device history table. Moreover, Hurtado's release of a decryption key to authorize download of content clearly does not disclose a **transfer** authorization request, by which authorization to render protected electronic content is transferred from a first device to a second device. There is no transfer whatsoever disclosed in col. 13, lines 10-20 of Hurtado, let alone the transfer authorization request as claimed.

Section 3 (page 3) of the Final Rejection alleges that Fig. 1D and associated written description of Hurtado discloses a method of transferring authorization to render content from a first device to a second device. Applicant respectfully disagrees with this allegation. Fig. 1D merely depicts operations between a content hosting site and an end user device. Fig. 1D fails to disclose the claimed transfer authorization request. In particular, Fig. 1D and associated description fail to disclose or even suggest transferring authorization to render content from a first device to a second device so that the first device is not authorized to render the content after such transfer.

Section 3 (page 3) of the Final Rejection alleges that col. 18, line 53 to col. 19, line 18 of Hurtado discloses "updating a first device history table to indicate that the first device is not authorized to render the protected electronic content and updating a second device history table to indicate that second device is authorized to render the protected electronic content based on the received transfer authorization request" as claimed. Applicant respectfully disagrees with this allegation. Col. 18, line 53 to col. 19, line 18 of Hurtado states:

409 Recipient verifies the digital signature in the sender's certificate by decrypting it with the public key of the certification authority. If the certificate's digital signature is valid, recipient acquires the sender's public key from the certificate.

410 Recipient decrypts the SC(s) digital signature using the sender's public key. This recovers the SC(s) digest. PB SENDER refers to the sender's public key.

411 Recipient runs the concatenation of the received content digest and encrypted key digest through the same hash algorithm used by the sender to compute the SC(s) digest.

412 Recipient compares the computed SC(s) digest with the one recovered from the sender's digital signature. If they are the same, recipient confirms that the received digests have not been altered and continues with the decryption process. If they are not the same, recipient discards the SC(s) and notifies the sender.

413 Recipient runs the encrypted symmetric key through the same hash algorithm used in step 411 to compute the symmetric key digest.

414 Recipient compares the computed symmetric key digest with the one received in the SC(s). If it is the same, recipient knows that the encrypted symmetric key has not been altered. Recipient continues with the decryption process. If not valid, recipient discards the SC(s) and notifies the sender.

415 Recipient runs the encrypted content through the same hash algorithm used in step 411 to compute the content digest.

416 Recipient compares the computed content digest with the one received in the SC(s). If it is the same, recipient knows that the encrypted content has not been altered. Recipient then continues with the decryption process. If not valid, recipient discards the SC(s) and notifies the sender.

As can be plainly seen from above, this passage of Hurtado fails to even mention a first device history table, a second device history table, or any indication that a device is no longer authorized to render protected content.

Dependent claims 64 and 116:

Dependent claims 64 and 116 further require updating the first device history table comprising **removing** a stored indicator of the protected electronic content from the first device history table. Section 10 (page 4) of the Final Rejection alleges that col. 71, lines 49-62 of Hurtado discloses these limitations. Applicant disagrees. Col. 71, lines 49-62 states the following:

Before transmitting the Content SC(s) 630 to the End-User Device(s) 109, analysis and verifications are performed on the End-User's request. A database is kept of all of the License SC IDs that have been used to download Content 113. This database can be checked to ensure that the End-User Device(s) 109 only makes one request for each piece of Content 113 purchased. This prevents

malicious users from repeatedly accessing the Content Hosting Site(s) 111 in hopes of slowing down the Content Hosting Site(s) 111 and prevents unauthorized download of the Content SC(s) 630.

The promotion and demotion of Content 113 to the Secondary Content sites is done periodically based on customer demand for the individual pieces of Content 113.

The above passages of Hurtado disclose a database of license SC IDs. However, this passage of Hurtado makes absolutely no reference to removing a stored indicator of content from a history table, let alone removing a stored indicator based on a received transfer authorization request (i.e., updating the first device history table comprises removing a stored indicator of the protected electronic content from the first device history table, the updating of the first device history table being based on the received transfer authorization request). The Final Rejection and Advisory Action fail to even address this previously submitted argument.

Dependent Claims 65 and 117:

Dependent claims 65 and 117 further require updating the first device history table comprises adding indicia that the protected electronic content is no longer authorized for the first device. Section 11 (page 5) of the Final Rejection alleges that col. 76, lines 43-60 of Hurtado discloses these limitations. Applicant disagrees. Col. 76, lines 43-60 states the following:

This stripped down Metadata SC(s) 620 is then included in the Offer SC(s) 641. The Electronic Digital Content Store(s) 103 also attaches its own Usage Conditions called Store Usage Conditions 519 or purchase options to the Offer SC(s) 641. This can be accomplished interactively or automatically through a set of defaults. If configured to be processed interactively, the Electronic Digital Content Store(s) 103 is prompted with the set of permitted object Usage Conditions 517 as defined by the Content Provider(s) 101. He then selects the option(s) he wishes to offer to his customers. These now become the new Usage Conditions or Store Usage Conditions 519. To process automatically, the Electronic Digital Content Store(s) 103 configures a set of default purchase options to be offered for all Content 113. These default options are automatically checked against the permitted Usage Conditions 517 defined by the Content Provider(s) 101 and is set in the Offer SC(s) 641 if there are no discrepancies.

FISCHER et al.
Application No. 09/363,413
February 15, 2008

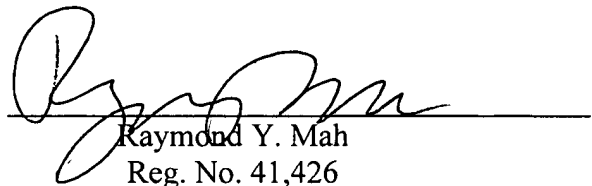
The above passage of Hurtado fails to disclose any indicia that protected content is no longer authorized for a device. Section 19 (page 6) of the Final Rejection alleges that "The 'indicia' as claimed by Applicant is broadly interpreted by the Examiner to pertain to the 'new Usage Conditions or Store Usage Conditions' as disclosed by Hurtado." Applicant respectfully disagrees with this interpretation. That is, Hurtado's usage conditions or storage usage conditions, even given its broadest reasonable interpretation, does not disclose the indicia added to a first device history that protected electronic content is no longer authorized for a first device. If anything, Applicant submits that these usage conditions merely set forth constraints, such as permitted number of copies or plays or a time interval or term that a license may be valid, offered to users/customers that the users/customers must agree to in order to become authorized. There is no indication of adding indicia to a first device table that a first device which was previously authorized is no longer authorized. That is, there is no teaching or suggestion of adding an indicia to a first device history to deauthorize a previously authorized first device.

Applicant therefore respectfully requests that the pre-appeal panel find that the application is allowed on the existing claims.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:


Raymond Y. Mah
Reg. No. 41,426

RYM:dmw
901 North Glebe Road, 11th Floor
Arlington, VA 22203
Telephone: (703) 816-4044
Facsimile: (703) 816-4100